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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,461	12/20/2005	Jan Vink	NL 030719	8224

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EXAMINER	
CARDWELL, ERIC	

ART UNIT	PAPER NUMBER
2189	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

Office Action Summary	Application No.	Applicant(s)	
	10/561,461	VINK, JAN	
	Examiner	Art Unit	
	ERIC S. CARDWELL	2189	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 December 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's Remarks/Arguments filed on October 28th, 2008, have been carefully considered.

Response to Amendment

Claim 8 has been amended.

Claims 1-9 are currently pending in the instant application

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widergren [US20040228169] in view of Chouinard [US6671701]. Widergren teaches a system and method of storing digital media in one format that can be converted to

another format. Chouinard teaches maintaining real-time synchronization of data in different formats. The examiner has reviewed the applicant's admitted prior art and has come to the understanding that the prior implementations of such devices used to supply media in various formats were of two basic designs. Design one is composed of a storage device that contains multiple copies of the same file in various formats (or contains a second format copy of each of a plurality of files) which requires large amounts of storage capacity. Design two is composed of a storage device that contains a single file format and a transcoder that is used to convert the single file into multiple formats (or is used to convert any of a plurality of files stored in a first format to a second format) and when a format is requested the transcoder requires a large amount of processing capacity and power. The examiner believes that the applicant's invention falls in the middle of these two designs and for that reason the examiner believes the applicant's invention to be rendered obvious.

Regarding claims 1 and 6-9, Widergren teaches a storage device [see Widergren's provisional application 60/471,151, page 1, last paragraph, lines 2, "...multimedia stored memory content..."] with an input for receiving a first data [Widergren page 1, last paragraph, line 7, "...hardware devices on which they are attached..."] set having a first format [Widergren page 2, second full paragraph, line 2, "...audio or video content on the same MMC..."]. The device contains various decoders [Widergren page 3, first partial paragraph, lines 5-6, "... decoder program for each operating system..."] that are used to transform the first data into a second data with a

different format than the first data [Widergren page 2, first full paragraph, lines 1-13, "... compress (encoded) format .... decode the content..."]. The device contains a storage medium for storing a set of first data pieces [Widergren page 1, last paragraph, line 3, "... storing information of interest ..."].

Widergren does not teach the use of a processor to search for the requested second data sets stored on the storage medium because Widergren does not teach storing the second data sets on the storage medium. Widergren teaches transcoding the data stored in the first format as needed by the user, using whichever conversion program is appropriate.

However, Chouinard does teach a processor [Chouinard figure 2, feature 106] that searches for the requested second data format stored on the storage medium [Chouinard column 3, lines 5-9 and claim 1, feature C].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Widergren's device so that it would store at least some transcoded files because storing transcoded files allows the device to provide these transcoded files immediately to the user, whereas Widergren's device has to transcode them each time they are desired by the user. While it is true that Widergren's device is more secure because it never stores a transcoded file, it would have been obvious to one of ordinary skill in the art at the time the invention was made to give up this security in some environments for the sake of improved speed of access. Storing the transcoded data on the storage device is also made obvious by Widergren's mention of security, as a reason for not storing the data, because that means that past

implementations had to have stored the transcoded data on the device for there to be a lack of security. The decision of whether to store the transcoded files on Widergren's device is a design choice with the tradeoff being reduced security for the decoded file but enhanced operation speed in providing the file to the user. In consumer devices, speed of access can be critical so it would have been obvious to one of ordinary skill in the art at the time the invention was made to give up the security provided by Widergren to get enhanced speed by storing decoded files. The finite size of Widergren's memory device would lead the skilled artisan to only store some of the files in the decoded format (no room for all of them) so if a user requests one that is not stored, it has to be transcoded.

Given the combination of references, if the search fails because there are no second formats available then the process proceeds as normal and Widergren will transcode the first data set into the second data set and supply it to the reproduction device [Widergren page 10, first paragraph, line 1, "... using a pocket pc, play the video."].

Regarding claim 2, as per the combination in claim 1, Widergren teaches a priority that a data set is never fully decoded into memory, only a subset of the file. The first half is deleted from memory when the second half is being decoded [Widergren page 12, second full paragraph, lines 1-2, "...never decrypted at once..."].

Regarding claim 3, as per the combination in claim 1, Widergren teaches a device that can be used for video or audio [Widergren page 2, second full paragraph, line 2, "...audio and video..."]. The device can be loaded with multiple decoders [Widergren page 3, first partial paragraph, lines 5-6, "... decoder program for each operating system..."], these decoders can be used as decompressors, because the first set of data is compressed [Widergren page 2, first full paragraph, line 3, "...compressed..."]. Thus the second set of data will be uncompressed and therefore larger in size than the first set.

Regarding clam 4, as per the combination in claim 1, Widergren teaches coupling the storage device to the reproduction device via a wireless channel [Widergren page 2, first full paragraph, line 8, "...cell phones..."].

Regarding claim 5, as per the combination in claim 1, Widergren teaches that the device can be used in cell phones to contain audio clips [Widergren page 13, first paragraph, last line, ".... PDA/Cell phone."]. The Examiner determines these devices to have the ability to pick up audio from a built in microphone that is used to transmit voice over a wireless connection. The examiner takes Official Notice that it would have been obvious at the time of the invention to modify a cell phone to store the transmitted audio for either personal records or entertainment purposes. It is also well known in the art that all cell phones by their inherent function have build in speakers for audio reproduction.

Response to Arguments

Applicant's arguments filed on October 28th, 2008, have been fully considered but they are not persuasive.

The applicant has questioned priority of the reference Widergren US US2004/0228169 and the examiner has concluded that provisional application 60/471,151 with a date of May 16, 2003 does have support for the subject matter relied upon as prior art in this office action. All the citations above refer to the provisional application.

The applicant also argues that the references fail to disclose "a processor that searches for a stored file in a second (transcoded) format and in response to not finding the file, transforming data received (not stored) form a first format into a second format". The examiner has rewritten the previous rejection so as to clarify any misunderstandings as to how the references combine to provide the features mentioned above.

The applicant also argues that the references fail to disclose a "predefined second data piece". The examiner has rewritten the previous rejection so as to clarify any misunderstandings as to how the references combine to provide the features mentioned above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC S. CARDWELL whose telephone number is (571)270-1379. The examiner can normally be reached on Mon-Fri 8am-5pm Eastern Alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reginald Bragdon can be reached on 571-272-4204. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eric S Cardwell/
Examiner
Art Unit 2189

/Kevin Verbrugge/
Primary Examiner, Art Unit 2189